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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,476	06/28/2001	Andrew Comas	72167.000564	5938
21967 7590 05/12/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER GRAHAM, CLEMENT B	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 05/12/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/894,476	<b>Applicant(s)</b> COMAS ET AL.	
	<b>Examiner</b> CLEMENT B. GRAHAM	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/17/01, 12/26/01, 12/18/07</u> .                            | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-12 remained pending in this Application.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend U.S Patent 6, 374, 358) in view of Srinivasan et al (Hereinafter Srinivasan U.S Patent 6, 895, 382).

As per claim 1, Townsend discloses a computer implemented method for structured development of migration options in a legacy transactional enterprise, the method comprising:  
identifying components of the legacy enterprise;  
developing risk factors for the components of the legacy enterprise; identifying unmet opportunities;  
developing risk factors for the unmet opportunities; identifying potential components for the legacy enterprise (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) developing risk factors for the potential components of the legacy enterprise; with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components and.(Note abstract and (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .  
Townsend fail to explicitly teach providing by a computer migration options and developing by a computer the migration options.

However Srinivasan discloses risk factors for Mitigation Plan Inadequate platform skills Gap analysis done and extensive training provided prior to the transition Loss of years of application skills due Key staff with critical skills will to transfer of work be retained for longer durations on the project before moving out Insufficient transfer of

skills to vendor Formal periodical and end of staff (during transition) transition reviews with each staff Each vendor staff to make presentation to current staff on knowledge gained Formal checklist will be used to sign off transition of each staff Attention of vendor staff immediately Incentive plans to ensure after skills transfer retention Adequate backup plans, cross training Non cooperation (or inadequate Project-end incentive plans, cooperation) of in-house staff during rewards and recognition transition Counselling prior to transition to ensure good (and visible) career path Non cooperation of current contract Agreements secured with staff during transition contracting company at an organisation level Inadequate/poor communication during Transparency in staff issues transition period leads to incorrect during transition rumours resulting in low Transition newsletter and employee morale other similar management communication cascading correct information.(see column 2 lines 1-76 and column 8 lines 18-46 and table 1, ,3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Townsend to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations to gain advantages of lower costs and significantly larger skill pools with equivalent or higher quality of service.

As per claim 2, Townsend discloses wherein the components of the legacy enterprise are selected from the group consisting of hardware or software. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 3, Townsend discloses wherein the unmet opportunities are selected from the group consisting of new hardware, new software or new business methods. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 4, Townsend discloses wherein the potential components for the legacy enterprise are selected from the group consisting of hardware or software. (see

column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 5, Townsend discloses wherein the potential components for the legacy enterprise include conceptual models of undeveloped capabilities. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 6, Townsend discloses wherein the risk factors include multiple variables. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 7, Townsend discloses wherein the risk factors are selected from the group consisting of cost or schedule. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 8, Townsend discloses wherein the migration options with associated risk factors are selected from the group consisting of existing components or conceptual models of undeveloped capabilities. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 9, Townsend discloses wherein the associated risks of the migration options are derived from the risk factors for the components of the legacy enterprise, the risk factors for the unmet opportunities, and the risk factors for the potential components of the legacy enterprise. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 10, Townsend discloses computer executable software code transmitted as an information signal, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:  
code to capture identity of components of the legacy enterprise;  
code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)  
code to capture risk factors for the unmet opportunities;

code to capture identity of potential components for the legacy enterprise (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) code to capture risk factors for the potential components of the legacy enterprise; and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

Townsend fail to explicitly teach providing by a computer migration options and developing by a computer the migration options

However Srinivasan discloses risk factors for Mitigation Plan Inadequate platform skills Gap analysis done and extensive training provided prior to the transition Loss of years of application skills due Key staff with critical skills will to transfer of work be retained for longer durations on the project before moving out Insufficient transfer of skills to vendor Formal periodical and end of staff (during transition) transition reviews with each staff Each vendor staff to make presentation to current staff on knowledge gained Formal checklist will be used to sign off transition of each staff Attention of vendor staff immediately Incentive plans to ensure after skills transfer retention Adequate backup plans, cross training Non cooperation (or inadequate Project-end incentive plans, cooperation) of in-house staff during rewards and recognition transition Counselling prior to transition to ensure good (and visible) career path Non cooperation of current contract Agreements secured with staff during transition contracting company at an organisation level Inadequate/poor communication during Transparency in staff issues transition period leads to incorrect during transition rumours resulting in low Transition newsletter and employee morale other similar management communication cascading correct information.(see column 2 lines 1-76 and column 8 lines 18-46 and table 1, ,3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Townsend to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support

and maintenance of software applications to off shore/off site locations to gain advantages of lower costs and significantly larger skill pools with equivalent or higher quality of service.

As per claim 11, Townsend discloses a computer-readable medium having computer executable software code stored thereon, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:

code to capture identity of components of the legacy enterprise;  
code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)  
) code to capture risk factors for the unmet opportunities;  
code to capture identity of potential components for the legacy enterprise(see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) code to capture risk factors for the potential components of the legacy enterprise, and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

Townsend fail to explicitly teach providing by a computer migration options and developing by a computer the migration options

However Srinivasan discloses risk factors for Mitigation Plan Inadequate platform skills Gap analysis done and extensive training provided prior to the transition Loss of years of application skills due Key staff with critical skills will to transfer of work be retained for longer durations on the project before moving out Insufficient transfer of skills to vendor Formal periodical and end of staff (during transition) transition reviews with each staff Each vendor staff to make presentation to current staff on knowledge gained Formal checklist will be used to sign off transition of each staff Attention of vendor staff immediately Incentive plans to ensure after skills transfer retention Adequate backup plans, cross training Non cooperation (or inadequate Project-end

incentive plans, cooperation) of in-house staff during rewards and recognition transition Counselling prior to transition to ensure good (and visible) career path Non cooperation of current contract Agreements secured with staff during transition contracting company at an organisation level Inadequate/poor communication during Transparency in staff issues transition period leads to incorrect during transition rumours resulting in low Transition newsletter and employee morale other similar management communication cascading correct information.(see column 2 lines 1-76 and column 8 lines 18-46 and table 1, ,3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Townsend to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations to gain advantages of lower costs and significantly larger skill pools with equivalent or higher quality of service.

As per claim 12, Townsend discloses a programmed computer for structured development of migration options in a legacy transactional enterprise, comprising: a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory; wherein the program code comprises:

code to capture identity of components of the legacy enterprise (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)

code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities;

code to capture risk factors for the unmet opportunities(see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)

code to capture identity of potential components for the legacy enterprise;

code to capture risk factors for the potential components of the legacy enterprise;

and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components.



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(see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Townsend to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations to gain advantages of lower costs and significantly larger skill pools with equivalent or higher quality of service.

**Conclusion**

3. Applicant's arguments filed 12/17/2007 has been fully considered but they are moot in view of new grounds of rejections.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

/Kambiz Abdi/  
Supervisory Patent Examiner, Art  
Unit 3692

CG

March 08, 2008